

I. Preliminary Remarks

This response is timely filed. Should the Patent Office determine that additional fees are required for consideration of this response, permission is hereby granted to charge such fees to Deposit Account No. 033975. Any overpayments should be credited to the same account.

II. Restriction

Citing 35 U.S.C. § 121, the examiner alleged that claims 1-24 are directed to the following five distinct inventions:

Group I. Claims 1-9 (claims directed to compounds and methods of treating cocaine abuse, depression etc.);

Group II. Claims 10-16 (claims directed to a method of controlling dopamine flow);

Group III. Claims 17-19 (claims directed to a method of modulating dopamine reuptake);

Group IV. Claims 20-22 (claims directed to a method of treating neurological disorder);

Group V. Claims 23, 24 (claims directed to compounds and method of treating cocaine abuse, depression, etc.).

III. Election

The applicants hereby elect Group I, which includes claims 1-9 directed to compounds and methods of treating cocaine abuse and depression amongst other conditions, with traverse.

IV. Traversal Arguments—Restriction of Claims 1-24 are Improper

The restriction requirement includes an allegation that claims 1-24 contain five groups without reason. See MPEP §803. Specifically, the examiner alleged that at least one Markush alternative in claim 1 is not novel over CA 74:68906. The examiner further asserted that under PCT Rule 13.2 and PCT Administrative Instruction Annex B (f)(B)(v), unity of invention can be reconsidered if at least one Markush alternative is not novel over the prior art. The examiner, however, in her consideration of the claims has provided no substantive

reason for why the claims should be restricted. PCT Administrative Instruction Annex B (f)(v) simply states “the question of unity of invention shall be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity shall be raised.”


The applicants request a substantive reason be provided for separating claims 1-24 into five groups since the alternative compounds of this Markush grouping are of similar nature in that (i) all alternatives have a common property or activity; (ii) a common structure is present; and it is a recognized class of compounds. See PCT Administrative Instruction Annex B (f)(i). The examiner has not provided an appropriate explanation for a separate classification of the claims and there does not appear to be a serious burden on the examiner to perform a search on these claims. Accordingly, the applicants request reconsideration of the restriction of claims 1-24.

V. Conclusion

In view of the foregoing, the applicant submits that they have fully and properly responded to the outstanding restriction requirement. Should the examiner have any questions or comments regarding this response or the application, the examiner is invited to contact the undersigned at the number indicated.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: 

Thomas A. Cawley, Jr., Ph.D.

Reg. No.: 40,944

Tel. No.: (703) 905-2144

Fax No.: (703) 905-2500

TAC/PAJ
1600 Tysons Boulevard
McLean, VA 22102
(703) 905-2000